

REMARKS

Please consider the present Remarks and accompanying declaration of Tomo Takayama.

Telephone Interview with Examiner Lien T. Tran

On March 21, 2007 applicant's associate attorney Gabor L. Szekeres (Registration number 28,675) had a brief telephone interview with Examiner Lien T. Tran. The prior art cited in the last Office Action and the scope of the present claims were discussed. The associate attorney urged that the claimed subject matter is patentably distinguishable from the cited art. Examiner Lien T. Tran stated that she will have to see applicant's response to the Office Action in writing to consider the matter. The Examiner's courtesy in granting this telephone interview is gratefully acknowledged.

Process Claims Are Patentably Distinguishable on the Basis of their Stated Use or Purpose

Claims 22 – 26 of the above-identified application were rejected as anticipated pursuant to 35 U.S.C. Section 102(b) by *Kametaka et al.* (Jp4063194755A). This reference was also applied against Claims 23 and 24 pursuant to 35 U.S.C. Section 103(a).

Claims 25 and 27 were rejected as anticipated pursuant to 35 U.S.C. Section 102(b) by *Yamasaki et al.* (Jp. 406000064A).

At the outset of these Remarks applicant notes that neither of the two cited references mentions in any way that the purpose of adding acid to noodles before frying (or otherwise) would be to reduce the formation of acrylamide. The present claims were amended to make it even more explicit that the claimed process is practiced for the purpose of obtaining fried noodles having a reduced acrylamide content. In contrast, the stated purpose of the *Kametaka* reference is to obtain fried food that does not generate blisters while being fried. The stated

purpose of the *Yamasaki* reference is to provide instant noodles that will be ready for eating after addition of hot water.

Applicant respectfully submits that their stated purpose is an important element of the present claims. The law is clear that

“‘[T]he dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference’s teaching that every claim [limitation] was disclosed in that reference.’ *Dayco Prods. Inc. v. Total Containment, Inc.*, F.3d 1358, 1368 (Fed. Cir. 2003)

In the present case it should be clear that no inference whatsoever could or would be drawn by one skilled in the art regarding the reference process’ ability to reduce acrylamide formation.

The Examiner expressed the view that the reference process will inherently decrease formation of acrylamide. However, this allegedly inherent result of the reference process does not negate the patentability of the instant process claims 22 – 25.

Under 35 U.S.C. §§ 100 and 101, new uses of a known process are patentable, except where the purpose of the new use is directed towards the same purpose as the known process. 35 U.S.C. §§ 100, 101; *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 471 F.3d 1363, 1368-69, 80 U.S.P.Q. 2d 1860 (Fed. Cir. 2006) (citing *Bristo-Meyers Squibb*, 245 F.3d 1368, 1376, 58 U.S.P.Q. 2d 1508 (Fed. Cir. 2001)). In *Abbott Labs.* the Federal Circuit reaffirmed its statement in *Bristo-Meyers Squibb* that new uses of a known process were indeed patentable if the purpose of the new use differed from the purpose of the known process. *Abbott Labs.*, 471 F.3d at 1368-69.

Clearly, the presently claimed process is used to reduce acrylamide formation. This is a new use (and purpose) within the meaning of the statutes 35 U.S.C. §§ 100, 101 and the above-cited court decisions.

In light of the foregoing the cited references would not legally prevent applicant from patenting the presently claimed new use of the process even if the claimed process were identical, except for use or purpose, with the prior art, which is NOT the case as shown below.

Claim 25 and the newly added dependent claims include additional features supported by the specification and clearly absent from the cited references

The specification discloses that after the noodle dough is prepared it is steamed and the acidic substance to bring the pH of the fried noodles below 6,5 is added after the steaming and before the frying. (see pages 10, 12 of the specification and numerous actual embodiments, for example Example 1, page 18) It should be generally understood, as is noted in the introductory section of the specification (pages 1 and 2), that the frying step is done to dry (dehydrate) the noodles. As is known by experience dehydrated noodles have a long shelf life without requiring refrigeration and need only addition of hot water to be reconstituted for human consumption.

The specification also discloses that in another alternative method or embodiment of the present invention a substance(s) is added to the noodles (noodle dough) that renders subsequent treatment with acid more effective or requires less acid to bring the pH below 6.5 in the fried noodles, thus the substances act as buffers. These substances are exemplified as “potassium carbonate, sodium hydrogencarbonate and sodium carbonate” (see pages 14 – 16) In each instance, whether the noodles include the “buffering” substances or not the adding of the acid to bring the pH below 6.5 is done after steaming and before frying of the noodles.

The above-discussed features are clearly absent from the two references cited against the claims. The reference *Kametaka et al.* specifically teaches "kneading the prepared dough raw material with an acidic solution containing acetic acid, citric acid, etc., and having a pH of 2-4, rolling the preapered dough". The reference *Yamazaki et. al.* specifically teaches that alginic acid is mixed with the raw material from which the noodle filaments are made. Therefore, these references do not describe identical steps with the present invention and clearly do not anticipate the claims. Nor would a combination of these two references result in the claimed claimed process. Moreover, a person of ordinary skill in the art would not find it obvious to modify the methods of either of the two cited references to make fried noodles containing a reduced amount of acrylamide.

Experiments Duplicating Examples of the Cited References Yielded Products of Less Than Acceptable Quality

Another reason why the cited references do not anticipate the present claims is that they do not provide products of the same quality as the presently claimed process. Mr. Tomo Takayama is a food chemist working for Toyo Suisan Kaisha Ltd. (the parent company of Maruchan Inc.) and is also a co-inventor of the present application. Mr. Takayama performed experiments following Example 1 of the cited *Kametaka* reference. He found that when acetic acid was added to the noodle material before frying, as described in the reference, the amount of acrylamide formed was indeed reduced but the resulting fried product was less than acceptable for commercial production because of bad (too acidic) taste or undesirable consistency.

Mr. Takayama also performed experiments following Example 2 of the cited *Yamasaki* patent reference. In this case when sodium alginate was added, as described in the reference, the pH of the resulting fried noodle was 7.02, thus having a pH which is neutral or very slightly

basic and certainly not within the scope of the present claims. These results are another reason for not considering the present claims anticipated or obvious over the cited prior art.

In the event the Examiner is of the opinion that a telephone conference with the undersigned attorney would materially facilitate the final disposition of this case, she is respectfully requested to telephone the undersigned attorney at the below listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.



Joseph W. Price
Registration No. 25,124
600 Anton Boulevard, Suite 1400
Costa Mesa, California 92626-7689
Telephone: (714) 427-7420
Facsimile: (714) 427-7799